THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte MAMORU NAKANISHI and MORIHIKO TOYOZUMI

_____

Appeal No. 1998-0153
Application No. 08/497,227

_____

ON BRIEF[1]

_____

Before HAIRSTON, FLEMING, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-11, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

[1] Appellants waived their oral hearing in a letter dated Feb. 28, 2000, therefore this case has been decided on the brief.

BACKGROUND

The appellant's invention relates to a buzzer driving device using a hysteresis circuit to compensate for fluctuations in signal levels. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A device connectable with a direct current source (1) for driving a buzzer (15), comprising:
>
> switch means (2) for coupling said direct current source (1) to said buzzer (15);
>
> a charging /discharging circuit (3) connected with the direct-current source (1) via said switch means (2) and which performs charging and discharging at a predetermined time constant (CR) when the switch means (2) is turned on and off, respectively, and produces an output voltage in accordance therewith;
>
> a hysteresis circuit (25) to which said output voltage of the charging/discharging circuit (3) is input and which operates while the output voltage rises to or above an operation threshold value (V_T) after the start of the charging of the charging/discharging circuit (3) and thereafter becomes inoperative and remains inoperative unless the output voltage falls to or below a stop threshold value (V_S) which is smaller than the operation threshold value (V_T) due to the discharging of the charging/discharging circuit (3); and
>
> driving circuit (14), connected between said hysteresis circuit (25) and said buzzer (15) for outputting a drive signal for said buzzer (15) in response to the operation of the hysteresis circuit (25).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dorais	4,188,549	Feb. 12, 1980
Ta	4,803,459	Feb. 07, 1989

Admitted prior art in Figures 4 and 5 and corresponding discussion in the specification.

Claims 1, 3-5, 7-9, and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art in view of Ta. Claims 2, 6 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art in view of Ta and Dorais.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed Dec. 20, 1996), examiner's letter (Paper No. 19, mailed May 16, 1997) and the supplemental examiner's answer[2] (Paper No. 20, mailed Jul. 10, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed Nov. 19, 1996) and reply brief (Paper No. 17, filed Feb. 21, 1997) for the appellants' arguments thereagainst.

OPINION

[2] We note that the supplemental examiner's answer is merely a copy of the prior examiner's answer without express responses to the arguments in the reply brief, and the examiner's letter stated that no further response by the examiner was needed.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

"To reject claims in an application under section 103, an examiner must show an unrebutted ***prima facie*** case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper ***prima facie*** case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of ***prima facie*** obviousness or by rebutting the ***prima facie*** case with evidence of secondary indicia of nonobviousness." **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we find that appellants have not overcome the ***prima facie*** case of obviousness by showing insufficient evidence of obviousness by the examiner or by rebutting the ***prima facie*** case with secondary evidence. Therefore, we will sustain the rejection of claims 1, 3-5, 7-9 and 11. With respect to claims 2, 6 and 10, appellants have successfully rebutted the examiner's position.

Appellants argue that Ta does not teach or suggest the same signal processing as appellants' invention. While we agree with appellants concerning the disclosed invention, we are constrained to review the examiner's rejection of the claimed invention as set forth in independent claims 1, 4 and 8 over the prior art combination of the admitted prior art in Figures 4 and 5 in view of the broad teachings and suggestion of Ta to use a delay and a Schmitt Trigger circuit to stablize the output of a comparator. (See Ta at col. 2, lines 47-51 and col. 6, lines 30-37.) As appellants recognize, the examiner has provided extensive discussion of the references and the operation thereof in combination, but appellants equate the quantity of detail as evidencing nonobviousness and use of hindsight in the examiner's formulation of the rejection. (See reply brief at pages 2-7.) We disagree with appellants and view the examiner's statements as providing a convincing line of reasoning.

Appellants argue throughout the brief that Ta has not recognized the same problem and that the goals and function of appellants' invention are different. (See brief specifically at page 11.) While we agree with appellants' statement, appellants have not addressed the claimed invention nor the combination of the teachings applied against the claims. Appellants argue at great length throughout the briefs the difference in signals between Ta and "appellants' invention," but appellants do not

identify specific claim language or address the combination of teachings. In our view,

the examiner has set forth a ***prima facie*** case of obviousness with the combination of the teachings of the admitted prior art and Ta. Appellants have not shown insufficient evidence by the examiner of obviousness or by rebutting the ***prima facie*** case with secondary evidence.

Appellants argue the language of claim 1 on page 9 of the brief, but address this language as it relates directly to the teaching of Ta rather than addressing the combination of the admitted prior art as modified by Ta. We disagree with appellants.

Appellants argue that the circuit of Ta would have to be modified in some manner in order to achieve the same operation as appellants' claimed circuit. (See brief at page 10.) We agree with appellants, but disagree that there is no suggestion in the prior art. Clearly, Ta discloses the usefulness of a Schmitt Trigger with hysteresis to stablize an output signal. (See Ta at col. 6, lines 30-37.) With this suggestion, in our view, the skilled artisan would have been motivated to stablize the output of the charging/discharging circuit of a buzzer for a seat belt or other accessory monitor. The skilled artisan would have therefore been required to interface the two components of the system together and the combination would have met the language of claim 1. This combination would have been clearly within the level of skill in the art. Therefore, we will sustain the rejection of independent claims 1, 4, and 8. Since appellants have

grouped all the dependent claims as falling with the independent claims, we will sustain the rejections of claims 3, 5, 7-9 and 11. (See brief at page 7.)

CLAIMS 2, 6 and 10

Even though appellants group all the claims with the independent claims, appellants specifically argue claims 2, 6 and 10. Therefore, we will address these claims separately. Appellants argue that one skilled in the art would not have been motivated to combine the teachings of Ta and Dorais. (See brief at page 15.) We agree with appellants. The examiner has not provided a convincing line of reasoning for the substitution of the Schmitt Trigger of Dorais for the Schmitt Trigger taught by Ta. The examiner merely concludes that they are equivalent and therefore, they each perform equally well. (See final rejection at page 4.) While we agree with the examiner that they both perform the function of a Schmitt Trigger, the examiner has not presented a convincing line of reasoning as to why one would make the substitution of the two inverters for the Schmitt trigger taught by Ta. (See answer at page 14 discussing “interchangeable.”) This substitution by the examiner was made with impermissible hindsight since the examiner did not provide reasoning why it would

have been obvious to make such a substitution. Therefore, we will not sustain the rejection of dependent claims 2, 6 and 10.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-5, 7-9 and 11 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 2, 6 and 10 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRM-IN-PART

KENNETH W. HAIRSTON Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
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